

ESTTA Tracking number: **ESTTA248785**

Filing date: **11/13/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91168674
Party	Plaintiff Pro-Football Inc. and NFL Properties LLC
Correspondence Address	Jonathan A. Scharf Quinn Emanuel Urguhart Oliver & Hedges LLP 51 Madison Ave., 22nd Floor new York, NY 10010 UNITED STATES jonathanscharf@quinnemanuel.com
Submission	Reply in Support of Motion
Filer's Name	Jonathan Scharf
Filer's e-mail	jonathanscharf@quinnemanuel.com
Signature	/Jonathan Scharf/
Date	11/13/2008
Attachments	2008-11-13 Reply in Support of Motion for Leave to Amend Notice of Opposition.pdf (7 pages)(222863 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD



Mark:

PRO-FOOTBALL, INC. and NFL
PROPERTIES LLC,

Opposers,

Opposition No. 91/168,674

-against-

PEAK PERFORMANCE PRODUCTION
AB,

Applicant.

**OPPOSERS' REPLY IN SUPPORT OF ITS MOTION FOR LEAVE
TO AMEND THE NOTICE OF OPPOSITION**

Opposers Pro-Football, Inc. and NFL Properties LLC move the Board for Leave to Amend the Notice of Opposition pursuant to TBMP § 507.01. Specifically, Opposers seek to



add the claim that Applicant does not have a *bona-fide* intent to use the designation in commerce. Applicant opposes Opposers' motion on the bases that (a) "the new claim sought to be included is legally insufficient," and (b) "Applicant will be prejudiced by Opposers' dilatory/bad faith motion" because of the timing of the motion. (Applicant's Brief in Opposition to Opposers' Motion for Leave to Amend the Notice of Opposition (hereinafter "Opposition Brief") at 2, 5.) In so arguing, Applicant attempts to confuse the Board by misstating the law, arguing the merits of Opposers' new claim rather than focusing on the legal

cognizability of that claim, and presenting irrelevant and incomplete facts about the timing of Opposers' motion.

ARGUMENT

The New Claim Is Legally Proper

As Opposers argued in their opening brief, the lack of a *bona-fide* intent to use the designation at issue on the goods and services listed in an application is proper grounds for opposition. See *Century 21 Real Estate Corp. v. Century Life of America*, 10 U.S.P.Q.2d 2034, 2035-6 (T.T.A.B. 1989). Applicant argues that because *Century 21* involved an application filed under Section 1(a) of the Lanham Act, instead of Section 1(b) as in this proceeding, it does not controlling. While Opposers contend that *Century 21* does control, the Board need not reach such a decision, as the Board has already restated the principles of *Century 21* in a Section 1(b) proceeding.

In *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503 (T.T.A.B. 1993), the opposer sought leave to amend its notice of opposition to add a claim nearly identical to the new claim sought here, following the applicant's failure to produce any documentary evidence of its intent to use the mark at issue. The Board held that "...the absence of any documentary evidence on the part of an applicant regarding [its intent to use its mark in commerce] is sufficient to prove that the applicant lacks a bona fide intention to use its mark in commerce as required by Section 1(b). **An allegation to such effect, therefore, states a claim on which relief can be granted.**" *Id.* at 1507 (emphasis added). Thus, there is no question that the claim Opposers seek to add is legally permissible.

Applicant attempts to distract the Board by proceeding to argue the merits of the new claim, offering flimsy excuses as to the reasons it has failed to produce any documentary




evidence of its intent to use the designation in the United States. Namely, Applicant points out that Opposers' document requests "improperly" requested that Applicant produce documents by photocopying and mailing them to Opposers' counsel's office. Applicant claims that the reason it did not produce any documentary evidence is that it "chose not to waive its proper objection to copying and mailing its document production to Opposer." (Opposition Brief at 4.) Applicant also claims that it did not answer any of Opposers' fifty-two interrogatories because they were excessive in number. (Id. at 3.)

Even assuming that Applicant's objections were appropriate, **Applicant neglects to mention that it also failed to make any responsive documents available for inspection and copying, or even identify whether such documents exist.** (See, generally, Applicant's Response to Opposers' First Set of Requests for the Production of Documents and Things, attached as Exhibit B to Opposers' opening brief.) On October 4, 2007, and then again on October 12, 2007, Opposers attempted to follow up with Applicant regarding its failure to identify responsive documents or make them available for inspection and copying. (See letter from Scharf to Cuccias, dated October 4, 2007 and email from Scharf to Cuccias, dated October 12, 2007, attached as Exhibits C and D, respectively, to Opposers' opening brief.) The October 4th letter explicitly demanded that Applicant identify whether it is in possession of any responsive documents and, if so, to identify when and where the documents would be made available for inspection. (See Exhibit C, at 1-2.) Applicant never responded and, to date, has not made any documents available for inspection or copying.


Applicant's failure to produce a single document or answer a single interrogatory

indicating a *bona-fide* intent to use the  designation in the United States gives rise

to a colorable claim that Applicant lacks a *bona-fide* intent to use the  designation in U.S. commerce. To the extent Applicant has offered excuses for its failures, such excuses should be heard on Applicant's trial motion and should not be considered in determining whether to grant leave to amend the Notice of Opposition to include the new claim.

Opposers' Motion Is Timely and Applicant Will Not Be Prejudiced

Applicant conflates the timeliness of Opposers' motion with prejudice to itself, ultimately reaching the unsupportable conclusion that Opposers' motion is made in bad-faith "as an alternative to a discovery motion, and/or an end run around the Board's rule precluding a party from addressing pre-trial discovery issues during trial." Opposers' motion for leave to amend is in no way a disguised discovery motion. Opposers do not seek to compel any documents or information from Applicant, nor do they seek a ruling that Applicant's discovery was incomplete. To the contrary, Opposers do not believe that Applicant failed to produce

documents evidencing an intent to use the  designation in United States commerce because of a discovery violation; rather, Opposers believe that Applicant failed to produce such documents because they do not exist, which is why Opposers now seek to add a claim supported by the absence of Applicant's evidence.

As to the timing of Opposers' motion, Applicant claims that because it was not filed during the pre-trial stage, it is untimely. But the Board may grant a motion for leave to amend a

pleading **at any stage of a proceeding**, and in fact liberally does so. TBMP § 507.02; *see Focus Int'l v. Pola Kasei Kogyo Kabusi Kaisha*, No. 19,611, 1992 WL 76584, at *2 (T.T.A.B. Feb. 27, 1992); *Flatley v. Trump*, 11 U.S.P.Q. 2d 1284,1286 (T.T.A.B. 1989); *Bufett v. Chi-Chi's, Inc.*, 226 U.S.P.Q. 428,43 1 (T.T.A.B. 1985). Here, Opposers filed their motion within one month of learning that Applicant had no documents to make available for inspection and copying, and within a mere ten days of following up on this issue by letter and email. Further, Opposers could not have filed this motion during the pre-trial stage, as Opposers' testimonial period opened on September 22, 2007, while Applicant's discovery responses were not served until September 24, 2007.

Finally, the fact that Opposers waited until the then-final day of their testimonial period to file the instant motion is irrelevant. First, Applicant's implication that Opposers' testimonial period has expired is untrue, as the parties, on October 22, 2007, stipulated to a suspension of these proceedings that postponed the close of Opposers' testimonial period. Upon resumption of these proceedings, Opposers' testimonial period will remain open. Second, Applicant could only possibly be prejudiced if the motion were filed well into its own testimonial period. Here, Applicant has its entire testimonial period remaining to address issues surrounding its lack of documentary evidence of its intent to use its applied-for designation. In fact, Applicant fails to offer an explanation as to how or why it would be prejudiced should the Board grant Opposers' motion. Indeed, Applicant cannot suffer prejudice from the addition of a claim based solely on information – or the lack thereof – in its own possession.

CONCLUSION

For the foregoing reasons, Opposers respectfully request that the Board issue an order granting leave to amend the Notice of Opposition, as revised in the Proposed Amended Notice of Opposition attached as Exhibit E to Opposers' opening brief.

Dated: November 13, 2008
New York, New York

Respectfully submitted,

Quinn Emanuel Urquhart Oliver & Hedges,
LLP

By: 

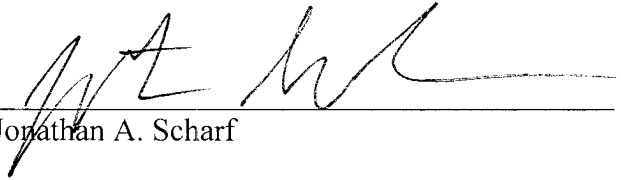
Robert L. Raskopf
Claudia T. Bogdanos
Jonathan A. Scharf

51 Madison Avenue
New York, New York 10010
Tel: (212) 849-7000
Fax: (212) 849-7100

ATTORNEYS FOR OPPOSERS PRO-
FOOTBALL, INC. AND NFL PROPERTIES,
LLC

CERTIFICATE OF SERVICE

I certify that on November 13, 2008, I caused to be served a copy of OPPOSERS' REPLY IN SUPPORT OF ITS MOTION FOR LEAVE TO AMEND THE NOTICE OF OPPOSITION by first-class mail to Matthew Cuccias, of Jacobson Homan PLLC, at 400 Seventh Street, N.W., Washington DC 20004.


Jonathan A. Scharf